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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/650,177
Filing Date: August 29, 2000
Appellant(s): CORDERY ET AL.

Brian A. Lemm, Reg. No. 43,748
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10 November 2005 appealing from the Office action mailed 09 June 2005.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Prior appeal to U.S. Application Serial No. 09/650,177

U.S. Application Serial No. 09/650,174

U.S. Application Serial No. 09/650,176

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,005,200	FISHER	4-1991
5,530,232	TAYLOR	6-1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Response to Arguments

According to the Applicant, the present method is distinguished from the prior art in that in the teachings of Fisher requires that a public/private key pair be generated and activated at the same time whereas in Applicant's method the private key is not activated until it has been determined that sufficient funds are present. The Examiner respectfully disagrees with Applicant's assertion. Regarding Applicant's teaching, Applicant's Disclosure is silent regarding a specific private key activation step. Therefore, for purposes of Examination "activating a private key" is equivalent to paying or deducting funds for obtaining a certificate (Specification, page 18, lines 5-7). In the Fisher system, a private key does not become "activated" until its public counterpart is certified by an authority ('200, column 18, lines 32-68) and an obvious modification of Fisher is to compensate an authority for providing certificate services ('200, figure 5).

Therefore, as Taylor teaches purchasing goods and services over the internet from a personal computer (i.e. meter) ('232, column 6, lines 55-68) it would have been obvious to one of ordinary skill to combine the teachings of Fisher and Taylor in order to pay for certification services.

The 112 Rejection is also maintained because the scope of claim 35 is not clear. Specifically, Applicant has not provided one of ordinary skill how the Applicant's method is to perform if there the register lacks sufficient funds.

The following assertion of facts has gone unchallenged by the Applicant and are now considered admitted prior art:

- implementing a postage meter within a personal computer

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 35 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35 recites performing the steps of "sending", "receiving", deducting" and "activating", "if sufficient funds are present". However, the Applicant has not provided one of ordinary skill how the Applicant's method is to perform if the

register lacks sufficient funds. Conditional statements necessarily embody two possibilities ("if" and "if not"), therefore, Applicant's method is broad enough to read on a method where the register lacks "sufficient" funds and the steps of "sending", "receiving", deducting" and "activating" do not take place.

Claim 37 is also rejected as it depends from claim 35.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher, U.S. Patent No. 5,005,200 in view of Taylor, U.S. Patent No. 5,530,232.

As per claims 35 and 37, Fisher teaches a method for obtaining a cryptographic certificate comprising: receiving at a device, such as the device of party A (column 9, lines 20-34), a request for a cryptographic certificate (column 3, lines 53-68; column 6, lines 36-65; column 18, lines 32-68). However, Fisher does not explicitly recite a metering device including a register having funds

stored therein. Taylor teaches metering device including a register having funds stored therein. Specifically, Taylor teaches a data card (column 6, lines 44-49) connected to a personal computer (column 6, lines 55-68) for making electronic purchases via modem (column 6, lines 63-67). One of ordinary skill in light of the teachings of Taylor would before making a purchase determine if the smart cash card (column 6, lines 44-49) had sufficient value in order to perform an electronic transaction (column 6, lines 56-64) such as an electronic purchase. Further, implementing a postage meter in a personal computer ('200, column 9, lines 20-34; '232, column 6, lines 55-58) is old and well known. Therefore, it would have been obvious to combine the teachings of Fisher and Taylor in order to allow a user to protect user financial information while making a purchase over an insecure network.

(10) Response to Argument

103 Rejection

Appellant is of the opinion that the combined prior art of Fisher and Taylor do not teach Appellant's claim 35. The Examiner respectfully disagrees.

Fisher teaches (Board Decision, dated 8-13-04, page 3, second full paragraph, lines 1-8) receiving at a device a request for a cryptographic certificate, generating at the device a cryptographic key pair, sending a certificate request to a certificate

authority wherein the request includes a public key of the key pair and activating the private key of the key pair ('200, column 3, lines 22-64; column 6, lines 36-65; column 18, lines 33-68). Appellant has amended the prior claim set (Board Decision, dated 8-13-04) to include the new language of "receiving at a *metering* device" and "in response to funds being deducted from the register, activating the private key of the cryptographic key pair". Regarding the limitation "determining if sufficient funds are present in the register for obtaining the certificate" the Examiner originally relied on the prior art of Payne et al. to teach this feature. However, the "determining" step of Payne et al. is at a remote server and not on the client side where a *metering device* (e.g. postage meter-see claim 37) comprising a register having funds stored thereon would reside. Taylor, on the other hand, teaches a cash value smart card ('232, column 6, lines 44-50) that is inserted into a computer PCMCIA slot ('232, column 6, lines 56-63) for making purchases online ('232, column 6, lines 62-63). Hence, Taylor teaches a device (e.g. PC-'232, column 6, lines 55-56) comprising a register (e.g. cash value smart card-'232, column 6, lines 44-46). Further, as PCs that function as postage meters are old and well known the device of Taylor is also a *metering device*.

The Board in its previous decision stated,

one of ordinary skill in the art at the time of appellants' invention would have recognized that the certification service provided by the trusted third party or governmental agency as discussed in the public key/signature cryptosystem and digital signature certification E-commerce system of Fischer '200 (e.g., at col. 11, lines 52+) would have required payment for the services rendered therein (Board Decision, dated 8-13-04, page 5, lines 1-10)

Therefore, following the Board's analysis, it would have been obvious to one of ordinary skill to use the metering device comprising a register having funds stored thereon (i.e. PC with a cash value smart card inserted into the PC's PCMCIA slot) taught by Taylor ('232, column 6, lines 45-49 and 56-68) to purchase a certificate from trusted third party or governmental agency (i.e. receiving at a metering device a request for a cryptographic certificate, the metering device including a register having funds stored thereon) (Board Decision, dated 8-13-04, page 5, lines 1-10; '232, column 6, lines 62-63). Regarding "determining if sufficient funds are present in the register for obtaining the certificate... and if sufficient funds are present...", it has been held that a reference is to be considered not for what it expressly states, but for what it would reasonably have suggested to one of ordinary skill of the art (*In re Delisle*, 160USPQ 806 (CCPA 1969)). Therefore, it would have been obvious to one of ordinary skill for a user to make sure there was enough money present in the cash value smart card of Taylor to support a transaction prior to engaging in a transaction, and to make a purchase if and only if the card contained sufficient value to cover the cost of the transaction. Similarly, it would have been to obvious automate this process in order to allow users to more efficiently determine the value of the card ("... it is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result (*In re Venner*, 262 F.2d 91, 95, 120 USPQ 192, 194 (CCPA 1958), *In re Rundell*, 18 CCPA 1290, 48 F.2d 958, 9 USPQ 220)). The Board has held that it would have been obvious to one of ordinary skill in view of Fisher to pay for a cryptographic certificate

(Board Decision, dated 8-13-04, page 5, lines 1-10). Hence, if the cash value of the card exceeded the cost of purchasing a certificate, a user would proceed with a transaction for obtaining a certificate which according to Fisher includes generating a cryptographic key pair including a public and private key ('200, column 18, lines 33-40).

Appellant asserts that Fisher is not applicable to claim 35 as Fisher teaches that a cryptographic key pair is generated and activated at the same time (Appeal Brief, page six, last paragraph, line 10). The Examiner respectfully disagrees. The public key certification process of Fisher is clear. First a key pair is generated by a user ('200, column 18, lines 34-37), the user then sends a public key of the key pair to a certification authority ('200, column 3, lines 45-53) which creates a certificate ('200, column 18, lines 43-68). Therefore, to one of ordinary skill generation and activation (i.e. certification) do not occur at the same time, as activation results from a user sending a public key of a generated pair to a certifying authority for certification. Taylor teaches making purchases from a metering device (i.e. PC) comprising a register with funds stored thereon ('232, column 6, lines 45-49 and 56-68), hence the Examiner contends an obvious modification of Fisher would be to purchase the certificate using (Board Decision, dated 8-13-04, page 5, lines 1-10) the cash value smart card inserted into a PC method (metering device comprising a register with funds stored thereon) as disclosed by Taylor. To one of ordinary skill, the Fisher and Taylor combination teaches "in response to funds being deducted from the register, activating the private key of the cryptographic key pair". More specifically, when a certificate authority creates a

certificate there is an associated expiration date ('200, figure 5; column 18, lines 62-68) which indicates to others utilizing the public key of user A to securely communicate with user A, the time period for which the key pair is valid or certified by the authority (i.e. activated). Further, in view of Taylor the receipt of the certificate is *in response to payment* or funds being deducted ('232, column 6, lines 45-49 and 56-68), therefore Fisher in view of Taylor sufficiently teaches "in response to funds being deducted from the register, activating the private key of the cryptographic key pair".

Regarding "activation step", the Examiner collated Appellant's Specification for a clear teaching of "activation". Knowing the references and given the history of the Application, the Examiner sought out language that perhaps could be added to the claims in order to further define "activation" as Appellant believed this to be a distinguishing feature over the cited prior art (Response to Non-Final, dated 4-22-05, page 5, lines 11-12; page 7, lines 9-10). However, Appellant's Specification only provides the following description:

Additionally at 520 the funds are deducted from the postage and certificate meter for the generation and the requested certificate which activates user's private key (Specification, page 18, lines 5-7)

Therefore, based on the claim and what *can* be determined from Appellant's Specification, the Examiner's statement in the Final Office Action was only meant to convey that the Examiner is not reading anything more into the term "activation" beyond "becoming active or having practical operation or results – i.e. effective" (Webster's

Ninth New Collegiate Dictionary, “activate” and “active”) as the Specification did not go into detail regarding “activating”.

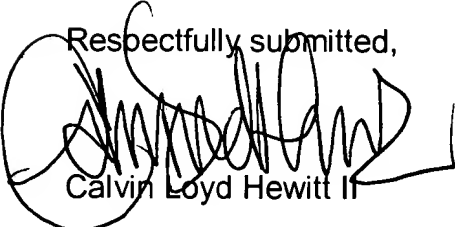
112 Rejection

In response to Appellant’s remarks (Remarks, 4-22-05, page 2, last full paragraph and continued into page 3) the Examiner maintained in the 112 Rejection. The Appellant has not argued the merits of the Examiner’s 112 rejection in this Appeal Brief.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner’s answer are provided herein. (References provided in Appellant’s Appeal Brief).

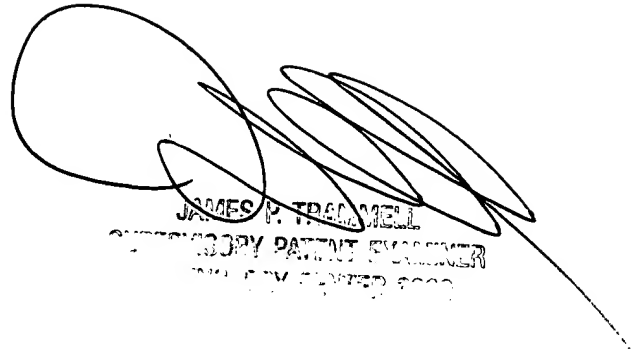
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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